



Docket No.: SON-2906
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yuji Shishido

Application No.: 10/506,433

Confirmation No.: 1276

Filed: April 4, 2005

Art Unit: 3682

For: BEARING UNIT AND ROTARY DRIVE
USING THE SAME

Examiner: L. A. Footland

PETITION UNDER 37 C.F.R. §1.144

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Petition under 37 C.F.R. §1.144 requesting review of the Restriction Requirement mailed in the above-identified application on September 1, 2006, and timely traversed within the Request for Reconsideration of Restriction Requirement under 37 C.F.R. §1.143 filed on November 1, 2006.

The Restriction Requirement of September 1, 2006 includes a restriction requirement under 35 U.S.C. §121.

In response, an election with traverse of that restriction requirement is found within the Request under 37 C.F.R. §1.143 for Reconsideration of Restriction Requirement filed on November 1, 2006.

Page 2 of the Office Action mailed on December 207, 2006 indicates that the Restriction Requirement has been made Final.

Accordingly, this petition pursuant to 37 C.F.R. §1.144 is proper. See 37 C.F.R. §1.144.

RESTRICTION REQUIREMENT

The Restriction Requirement of September 1, 2006 asserts an existence of the following patentably distinct inventions:

- The Species of Figure(s) 4-5 versus that of Figure 6 versus Figures 7-9c v Figures 10 v 11 v 12a-13d v 14 v 15 v 16 v 17 v 18-19 v 20 v 21 v 22 v 23 v 24 v 25 v 28 v 29 v 30 v 31 v 32 v 33 v 38.

ELECTION

As noted in the second sentence of 37 CFR 1.143, a provisional election must be made even though the requirement is traversed. M.P.E.P. §818.03(b).

Accordingly, the Request under 37 C.F.R. §1.143 for Reconsideration of Restriction Requirement of November 1, 2006 includes a provisional election, WITH traverse, of the invention of the alleged species directed to Figure 17, having claim 23-29 readable thereon.

ARGUMENTS

M.P.E.P. §806.04(b) further instructs that *where inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in M.P.E.P. §§806.05 - 806.05(j).*

As least for the following reasons, the Restriction Requirement fails to determine the question of restriction by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in M.P.E.P. §§806.05 - 806.05(j).

Specifically, claims 24-29 are dependent upon claim 23. Claim 23 is drawn to a bearing unit comprising:

a shaft;

a radial bearing for peripherally supporting the shaft;

a thrust bearing for supporting an end of the shaft in the thrusting direction thereof;

a space-forming member arranged outside the radial bearing and the thrust bearing;

a housing having the space-forming member in the inside and hermetically sealed except a shaft receiving hole through which the shaft is made to extend;

viscous fluid filled in the housing; and

a communication passage way arranged between the space-forming member and the radial bearing so as to make the end in the thrusting direction of the shaft projecting from the radial bearing and the other end of the shaft communicate with each other.

Procedures within the U.S. Patent and Trademark Office dictate that *where species under a claimed genus are not connected in any of design, operation, or effect under the disclosure, the species are independent inventions*. M.P.E.P. §806.04(b).

However, the Restriction Requirement *fails to show* that the features found within Figures 17-25, 28-33 and 38, and specifically each of the Figures 17-19, *are not connected* in any of design, operation, or effect under the disclosure.

Thus, the Restriction Requirement *fails* to show that the alleged species found within these figures are independent inventions.

Moreover, procedures within the U.S. Patent and Trademark Office further dictate that *where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.* M.P.E.P. §808.01(a).

Here, the specification as originally filed, in the paragraph beginning at page 50, line 16, provides that now, the bearing unit 330 that is used in the motor 301 will be described in GREATER DETAIL below.

In this regard, the specification as originally filed, in the paragraph beginning at page 50, line 18, provides that as shown in FIGS. 17, 18 AND 19, the bearing unit 330 that rotatably supports the rotary shaft 331 of the above described motor 301 comprises a radial bearing 333 for peripherally supporting the rotary shaft 331, a space-forming member 334 formed outside the radial bearing 333, a housing 337 containing the space-forming member 334 and a communication passage way 350 formed between the space-forming member 334 and the radial bearing 333.

Yet, the Restriction Requirement fails to present a discussion at least between the features found within each of the Figures 17-19 and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction of these figures.

Election of species should not be required between claimed species that are considered clearly unpatentable (obvious) over each other. M.P.E.P. §808.01(a).

Finally, practice and procedures within the U.S. Patent and Trademark Office dictate that *if restriction is improper under either practice, it should not be required.* M.P.E.P. §806.04(b).

Thus, the Restriction Requirement should not be required at least for these reasons.

RELIEF

Applicant requests that the Commissioner exercise his supervisory authority under 37 C.F.R. §1.144 and withdraw this improper Restriction Requirement.

No fee is believed to be required in connection with this petition.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: September 17, 2007

Respectfully submitted,

By

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